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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thomsen
Serial No.: 09/381,771
Filed: September 23, 1999
Art Unit: 3626
For: FIGURATIVE PRINT ON A PLANE PRINT CARRIER
AND USE OF SUCH FIGURATIVE PRINT
Examiner: E. Peavey

TRANSMITTAL OF APPEAL BRIEF

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Honorable Commissioner
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Enclosed is an original brief to the Board of Patent Appeals and Interferences and three photocopies thereof. This brief is being filed pursuant to the Notice of Appeal apparently accorded an Office filing date of October 15, 2002. The Rule 17 fee for filing an appeal brief is enclosed. Any other fees may be charged to Deposit Account 50-1145, Order No. 2424-19.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

#12 / Appeal
Bray
12/27/02

Application Serial No. 09/381,771

Filed: September 23, 1999

Art Unit: 3626

Examiner: E. Peavey

FIGURATIVE PRINT ON A PLANE PRINT CARRIER
AND USE OF SUCH FIGURATIVE PRINT

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Ex parte: Erik Brogaard Thomsen

BRIEF FOR THE APPELLANT

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Pitney, Hardin, Kipp & Szuch LLP
Attorneys for the Appellant

I. REAL PARTY IN INTEREST

The real party in interest is assignee Logo Paint.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 9-17 are rejected.

IV. STATUS OF AMENDMENTS

An after-final Office Action was dated April 9, 2002. No after final amendments were filed. A Notice of Appeal was dated October 9, 2002, with a return postcard indicating an Office filing date of October 15, 2002.

V. SUMMARY OF INVENTION

The invention is a figurative print which is applied to a plane print carrier so that the print appears in the best possible way, such as creating the optical illusion of the print being formed with a three-dimensional effect or perpendicularly to the plane print carrier (page 3, last paragraph, also see Fig. 1).

This is achieved by a figurative print wherein the primary figurative element as seen in a direction perpendicular to the plane print carrier is applied with an angular displacement α of the figurative element as compared to a perpendicular view of the figurative element on the plane

print carrier, and that the angular displacement α is equal to an angle between a perpendicular view of the print and an oblique view of the print relative to the perpendicular view (see Fig. 3).

The oblique viewing of the print may correspond to an angle at which a TV camera is placed as compared to a perpendicular viewing of the print. The oblique viewing of the print may also correspond to an angle that, for example, drivers on a road pass as seen in relation to a perpendicular viewing of the print. The oblique viewing of the print may be any angle so that the print appears in the best possible way before a viewer in a given position relative to the print, such as, corresponding to a perpendicular view facing the viewer (page 4, lines 10-15).

In a preferred embodiment of the figurative print according to the invention, the print comprises a secondary figurative element depicting the information in a third dimension (page 3, lines 19 and 20), that the secondary figurative element as seen in a direction perpendicular to the plane print carrier is applied with an angular displacement β of the figurative element as compared to a perpendicular view of the figurative element on the plane print carrier, and that the angular displacement β is equal to an angle between a perpendicular view of the print and an oblique view of the print relative to the perpendicular view (page 2, lines 7-14).

By imparting a secondary figurative element to the print, it is possible to achieve a three-dimensional effect of the print for the viewer in question. As the primary figurative element, the secondary figurative element is subjected to an angular displacement which results in a three-dimensional effect that is the best possible for the viewer in question, that is, a three-dimensional effect corresponding to a perpendicular viewing of the print (page 2, lines 16-21).

A secondary figurative element may be a shadow effect, a relief effect or another three-dimensional effect of the primary figurative element. In alternative embodiments, the print is

provided with a tertiary figurative element that may comprise a foreground, a background or a frame (page 2, lines 23-26).

VI. ISSUES

1. Do claims 9-17 define a claimed invention with patentable utility under 35 U.S.C. §101?
2. Are claims 9-15 patentable under 35 U.S.C. §102 over the Fontworks reference?
3. Are Claims 16 and 17 patentable 35 U.S.C. §103 in view of the Fontworks reference in view of the Rusin reference (U.S. Patent No. 5,941,002)?

VII. GROUPING OF CLAIMS

The claims are deemed to stand or fall together for each ground of rejection.

VIII. ARGUMENTS

1. Do claims 9-17 define a claimed invention with patentable utility under 35 U.S.C. §101?

The Appellant respectfully submits that the presently pending claims recite something other than unpatentable “printed subject matter”. It is further respectfully submitted that the presently pending claims define an invention which clearly has patentable utility.

35 U.S.C. §101 states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

As stated recently by the Federal Circuit with respect to 35 U.S.C. §101:

The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103 and 112, ¶2.

The repetitive use of the expansive term “any” in §101 shows Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recite in §101. Indeed the Supreme Court has acknowledged that Congress intended §101 to extend to “anything under the sun that is made by man.” Diamond v. Chakrabarty, 447 U.S. 303, 309 [206 USPQ 193] (1980); *see also* Diamond v. Diehr, 450 U.S. 175, 182 [209 USPQ 1] (1981). Thus it is improper to read limitation into §101 on the subject matter that may be patented where the legislative history indicates that Congress did not intend such limitations. *See* Chakrabarty, 447 U.S. at 308 (“We have also cautioned that courts ‘should not read into the patent laws limitations and conditions which the legislature has not expressed’” (citations omitted)).

State Street Bank & Trust v. Signature Financial Group, 47 USPQ2d 1596, 1600 (Fed.Cir. 1998) (footnotes omitted).

The Federal Circuit in State Street further supported the above language by legislative history in that “The Committee Reports accompanying the 1952 Act inform us that Congress intended statutory subject matter to ‘include anything under the sun that is made by man.’ S. Rep. No. 82-1979 at 5 (1952); H.R. Rep. No. 82-1923 at 6 (1952).” *ibid.* at 1600, note 3.

The Federal Circuit then used this reasoning to lay to rest the “ill-conceived exception” of the “business method exception”, and stated “Since the 1952 Patent Act, business methods have

been, and should have been, subject to the same legal requirement for patentability as applied to any other process or method.” ibid. at 1602 (footnote omitted).

It is respectfully submitted that no principled distinction can be drawn between the above language with respect to the “ill-conceived ... business method exception” and any alleged “printed materials exception”, particularly when the claimed invention is not drawn to any particular words or specific graphics. Rather, the presently claimed invention recites a structural, albeit planar, configuration wherein a specific visual effect may be achieved for virtually any textual image. It is respectfully submitted that the claimed invention falls into many of the various categories of 35 U.S.C. §101 – a manufacture, a composition of matter, perhaps a process, and new and useful improvements thereof¹.

The utility of the present invention cannot be denied. An apparently three dimensional image can be created at a specific angle, for example, for a television camera to broadcast without the need to create the corresponding three dimensional image on an athletic field. Certainly, the patentability of this invention cannot be rejected as being similar to a double-entry accounting form or a specific textual printing.

Indeed, the patentability of the presently claimed invention can be harmonized with ancient case law regarding the so-called “printed materials exception”. It is stated in In re Gwinn, 112 USPQ 439, 446 (Pat.Off.Bd.App. 1955), “it is only where the claims define *either* new features of structure *or* new relations of printed matter to structure, *or* both, which new features or new relations give rise to some new and useful function or effect or result that claims may properly be allowed”. (italicization in original). It is respectfully submitted that the apparent three-dimensional effect of the presently claimed invention is the functional equivalent

¹ Certainly the presently claimed invention meets the “anything under the sun that is made by man” of the legislative history and Chakrabarty.

of a “new relation of printed matter to structure” and is certainly a “new and useful function or effect or result”.

It is therefore respectfully submitted that the presently pending claims recite a patentable utility and are clearly patentable under 35 U.S.C. §101.

2. Are claims 9-15 patentable under 35 U.S.C. §102 over the Fontworks reference?

The Appellant respectfully submits that the figurative element disclosed in the Fontworks reference, when seen in a given oblique direction between a view and the print, shows the first dimension and the second dimension as forming a plane of advertisement which is directed obliquely outward of the plane of the print carrier.

It is respectfully submitted that the Fontworks reference discloses an inverse perspective formed image, having a line of sight being perpendicular to the plane of the print carrier. Accordingly, the Fontworks reference shows only a print having a vanishing point perpendicular behind the plane (that is, the page), or perpendicular in front of the plane.

While the inverse perspective formed image of the Fontworks reference may be construed as having the appearance of depth, this appearance has been added through a shadow which is comparable to the secondary figurative element in the present application. Therefore, it is not possible to obtain the same effect obtained with the present invention, according to which the primary figurative element, seen in a given oblique direction, shows the first figurative element as being directed obliquely outward of the plane of the print carrier.

Regardless of the angle of view of the “Sanity” picture from the Fontworks reference, it will appear as described above. Accordingly, it is not possible to “raise” the primary figurative element out of the plane of the print carrier (that is, the page). The only effect which can be said

to be obtained is that the primary figurative element could either be in the plane of the print carrier or in a plane being parallel to the plane of the print carrier. However, the "Sanity" picture illustrates the shading which will be vanishing into the paper with different angles for each of the elements in the picture. Accordingly, one could say the primary figurative element in the X-Y plane illustrated by the Fontworks reference will be in the plane of the print carrier. Further, it is also noted that the Fontworks reference does not have the secondary figurative element (the shading of the primary figurative element) arranged in such a way that it will have an angle of $\alpha+\beta$ between the first dimension and an angle of $\beta+90^\circ$ between the first dimension and the second dimension. It clearly occurs that the angle for each of the elements of the primary figurative element will differ from the angle in any of the other figurative elements, when seen in any given oblique direction between the viewer and the print.

Finally, it should be noted that the third dimension (the depth) will not have an angle differing from zero, at least not when one looks at the figurative element which is arranged in the middle of the depicted figurative element. In the central part, the angles α , β will be zero degrees.

It is therefore respectfully submitted that Claims 9-15 are patentable over the Fontworks reference.

3. Are Claims 16 and 17 patentable 35 U.S.C. §103 in view of the Fontworks reference in view of the Rusin reference (U.S. Patent No. 5,941,002)?

As described in numbered paragraph 2 hereinabove, the Fontworks reference is not a relevant reference against the presently claimed invention. It is further respectfully submitted that the Rusin reference, which appears to be merely a structural support systems for signs, does

nothing to remedy the deficiencies of the Fontworks reference. Therefore, Claims 16 and 17, which are ultimately dependent upon Claim 9, are patentable over the cited combination of references.

In view of the above, it is respectfully submitted that the pending claims are patentably distinct from the art of record.

The Board is respectfully requested to find all of the presently pending claims to be allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald Levy", with a stylized flourish extending from the end.

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IX. APPENDIX OF PRESENTLY PENDING CLAIMS

9. An advertisement print being printed on a plane print carrier, and which print is plane and lies in the same plane as the print carrier and comprises a primary figurative element depicting an advertisement in a first dimension and a second dimension, which primary figurative element when seen in a direction perpendicular to the plane of the print carrier constitutes an angle $\alpha+90^\circ$ between the first dimension and the second dimension, and which primary figurative element when seen in a given oblique direction between a viewer and the print shows a first dimension and the second dimension as forming a plane of advertisement, which plane of advertisement is directed obliquely outwards of the plane of the print carrier, wherein the advertisement print comprises a secondary figurative element depicting the advertisement in a third dimension, that the secondary figurative element when seen in a direction perpendicular to the plane print carrier constitutes an angle $\alpha+\beta$ between the first dimension and the third dimension and an angle $\beta+90^\circ$ between the first dimension and the third dimension and which secondary figurative element when seen in the given oblique direction between the viewer and the print shows the third dimension as directed perpendicular to the plane of advertisement being formed by the first and the second dimension and that the angles α, β are different from 0° .

10. An advertisement print according to claim 9, wherein the secondary figurative element is a shadow of the primary figurative element.

11. An advertisement print according to claim 9, wherein the secondary figurative element is a relief of the primary figurative element.

12. An advertisement print according to claim 9, wherein the print comprises a tertiary figurative element depicting surroundings of the primary and secondary figurative element, that the tertiary figurative element when seen in a direction perpendicular to the plane print carrier is applied with an angular displacement and which tertiary figurative element when seen in the given oblique direction between the viewer and the print shows the tertiary element as being plane and lying in the plane of the print carrier.

13. An advertisement print according to claim 12, wherein the tertiary figurative element constitutes a foreground, a frame, or a background.

14. An advertisement print according to claim 9, wherein the print is made of a curable, liquid printing ink, that the ink is applied to the plane print carrier in a liquid state, and that the ink is cured on the plane print carrier.

15. An advertisement print according to claim 9, wherein the print is made by printing on a carrying medium and that the carrying medium is laid on the plane print carrier.

16. An advertisement print according to claim 11, wherein the plane print carrier is a ground surface.

17. An advertisement print according to claim 9, wherein the plane print carrier is a vertical surface.